

ESTTA Tracking number: **ESTTA740887**

Filing date: **04/19/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062356
Party	Defendant Air1st Aviation Companies, Inc. dba Air1st
Correspondence Address	MITCHELL B SNYDER WARLICK STEBBINS MURRAY & CHEW LLP POST OFFICE BOX 1495 AUGUSTA, GA 30903-1495 UNITED STATES cstebbins@wtstmlaw.com, msnyder@wtstmlaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Mitchell B. Snyder
Filer's e-mail	msnyder@wtstmlaw.com
Signature	/Mitchell B. Snyder/
Date	04/19/2016
Attachments	Answer to Amended Petition for Cancellation.pdf(191372 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>In re Matter of Application Ser. No. 86/497,484 for the mark: PLATINUM SERIES</p> <p>In re Matter of Reg. No . 4,726,130 for the mark: PLATINUM SERIES MU-2</p> <p>Concorde Battery Corporation,</p> <p style="text-align:center">Opposer and Petitioner,</p> <p style="text-align:center">vs.</p> <p>Air 1st Aviation Companies, Inc.,</p> <p style="text-align:center">Applicant and Registrant.</p>	<p>Opposition No. 91-224081 (parent) Cancellation No. 92-062356</p>
--	---

Registrant Air 1st Aviation Companies, Inc.’s Answer to Amended Petition for Cancellation

Registrant Air 1st Aviation Companies, Inc (“Registrant”) hereby answers the Amended Petition for Cancellation filed by Petitioner Concorde Battery Corporation (“Petitioner”) as follows:

In response to the introductory unnumbered paragraph, Registrant denies Petitioner’s allegation that it will be damaged by the continued existence on the Principal Register of the mark PLATINUM SERIES MU-2 for “refurbished airplanes” in International Class 12 as shown in Registration No. 4,726,130. Registrant also shows that the application for Registration No. 4,726,130 was signed on October 11, 2013 and therefore denies it was registered on April 28, 2015 but admits that a Registration Certificate was issued on April 28, 2015. Registrant admits that its principal office address is 234 Air Park Blvd, Aiken, SC 29805-8921 and that Registrant registered the Mark and is a corporation organized and existing under the laws of the State of Georgia. Furthermore Registrant denies each allegation of the Petition for Cancellation except as

specifically admitted or otherwise qualified below. For its answer to each particular paragraph, Registrant states and alleges as follows:

1. Registrant lacks sufficient knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 and, therefore, denies the same.

2. In response to paragraph 2, Registrant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 2 and, therefore, denies the same. Registrant admits that based on the United States Patent and Trademark Office documents available online it does appear that Concorde Battery Corporation is the owner of U.S. Registration No. 2,734,038 for the mark “Platinum Series” with a Registration Date of July 8, 2003 and is registered for “AIRCRAFT BATTERIES”.

3. Registrant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3 and, therefore, denies each and every allegation in paragraph 3.

4. Registrant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 4 and, therefore, denies each and every allegation in paragraph 4.

5. Registrant admits it filed the Application with the U.S. Patent and Trademark Office to register PLATINUM SERIES MU-2 (Serial No. 86/089,204) in connection with “refurbished airplanes” in International Class 12 on October 11, 2013 and that the Registrant listed its first use in commerce date and first use at least as early as August 21, 2012. Except as expressly admitted, Registrant denies each and every allegation in paragraph 5.

6. Applicant admits it assigned its rights in the Platinum Series MU-2 mark, and the goodwill related thereto, to Mitsubishi Heavy Industries America, Inc., (“Mitsubishi”). Applicant

admits that a true and correct copy of the Assigned as recorded with the United States Patent & Trademark Office on or about October 16, 2015 is attached as Exhibit B to the First Amended Petition for Cancellation. Except as expressly admitted, Registrant denies each and every allegation in paragraph 6.

7. Registrant admits the application, Serial No. 86/069,204 was issued a registration certificate on April 28, 2015.

8. Registrant responds that it lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 8 and, therefore, denies each and every allegation in paragraph 8.

9. Registrant denies that its mark for PLATINUM SERIES MU-2 is similar in appearance, sound, connotation, and commercial impression to Petitioner's PLATINUM SERIES mark.

10. Registrant denies each and every allegation in paragraph 10.

11. Registrant lacks sufficient knowledge or information to form a belief as to the truth of Petitioner's belief. Registrant denies the remainder of Paragraph 11.

12. Registrant denies the allegations contained in Paragraph 12.

13. Registrant denies the allegations contained in Paragraph 13.

14. Registrant admits that it previously assigned the PLATINUM SERIES MU-2 mark to Mitsubishi and admits that it seeks registration of the PLATINUM SERIES mark for "refurbished airplanes" in International Class 12. Registrant denies the remainder of Paragraph 14.

15. Registrant denies each and every allegation in paragraph 15.

16. Registrant denies each and every allegation in paragraph 16.

17. Registrant lacks sufficient knowledge or information to form a belief as to the truth concerning Petitioner's belief and therefore denies this allegation and the remaining allegations contained in paragraph 17.

FIRST DEFENSE

18. Petitioner has not pleaded any law or fact that justify the cancellation of Registrant's mark "PLATINUM SERIES MU-2".

SECOND DEFENSE

19. Registrant has for years demonstrated valid use in commerce of the now-registered mark, "PLATINUM SERIES MU-2," including in advertisements, on its Website, and generally in commerce which display PLATINUM SERIES MU-2 in a manner in which customers will recognize it as a mark, with means of ordering the goods, in this case a telephone number.

20. The United States Patent and Trademark Office issued a registration certificate on April 28, 2015 which recognized that Registrant's mark, "PLATINUM SERIES MU-2" was entitled to a trademark.

21. Registrant is entitled to the continued use of its trademark and a denial of the petition for cancellation.

THIRD DEFENSE

22. Petitioner has used and promoted its registered mark exclusively in connection with a specific battery and, as a result, Petitioner will not be damaged by Registrant's mark associated with refurbished airplanes.

23. Petitioner's claims are barred, in whole or in part, because Petitioner has not and will not suffer any injury or damage from the existence on the Principal Register of the mark

PLATINUM SERIES MU-2 for “refurbished airplanes” in International Class 12 as shown in Registration No. 4,726,130.

FOURTH DEFENSE

24. Registrant’s mark differs in terms of the overall meaning and has a distinct commercial impression from the Petitioner’s mark.

25. Registrant’s adoption and use of the term PLATINUM SERIES MU-2 distinguishes itself from the Petitioner’s mark of PLATINUM SERIES because an MU-2 refers to a specific type of aircraft as opposed to a battery.

26. Registrant’s marks are directed to a different market segment than Petitioner’s marks.

27. Registrant’s use and registration of Registrant’s mark does not create a likelihood of confusion, to cause mistake, and to deceive potential customers.

FIFTH DEFENSE

28. Upon information and belief, the adoption and use of the terms PLATINUM SERIES is part of numerous registered and other common law third party marks for goods in a variety of International Classes that are not owned by Petitioner. Thus, confusion is unlikely given the coexistence of the numerous PLATINUM SERIES marks. The existence of such registered third party marks requires that the Petitioner’s mark be narrowly construed, such that Petitioner’s mark cannot—as a matter of law—form the basis of likelihood of confusion claim against Registrant’s mark.

SIXTH DEFENSE

29. Registrant has used its mark in the United States and has not experienced any confusion with Petitioner, Petitioner's mark, or Petitioner's goods. On information and belief, Petitioner has not experienced any actual confusion either.

SEVENTH DEFENSE

30. Registrant's mark was published on September 9, 2014. Petitioner filed its Petition for Cancellation on September 28, 2015, nearly an entire year after the mark was first published. Petitioner's delay in asserting its claim was inexcusable and caused undue prejudice to Registrant when, among other things, Registrant spent money, time, and effort to market and develop its mark. Therefore, Petitioner's claim should be barred by the doctrine of laches.

PRAYER FOR RELIEF

WHEREFORE, having fully answered the Petition for Cancellation, Air 1st Aviation Companies, Inc. respectfully prays:

1. That the Petition for Cancellation be dismissed with prejudice;
2. That the Registration No. 4,726,130 be allowed to remain on the Principal Register; and
3. That Registrant be granted further reasonable and appropriate relief as the Board deems just and proper.

This 19th day of April, 2016.

Respectfully submitted,

/Clay Stebbins/
Charles C. Stebbins, III

Attorney for Registrant
Georgia Bar No.: 677350
cstebbins@wtsmlaw.com

/Mitch Snyder/
Mitchell B. Snyder
Attorney for Registrant
Georgia Bar No.: 382138
msnyder@wtsmlaw.com

WARLICK, STEBBINS, MURRAY & CHEW, LLP
Post Office Box 1495
Augusta, Georgia 30903-1495
(706) 722-7543

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant Air 1st Aviation Companies, Inc.'s Answer to Opposer's First Amended Petition for Cancellation has been served on counsel for Concorde Battery Corporation, by mailing said copy on April 19, 2016, via First Class U.S. Mail, postage prepaid to:

Paul Bost, Esq.
Sheppard, Mullin, Richter & Hampton, LLP
1901 Avenue of the Stars Suite 1600
Los Angeles, CA 90067

And additionally will be transmitted electronically through the ESTTA Filing System to the United States Patent and Trademark Office on this day.

This 19th day of April, 2016.

/Mitch Snyder/
Mitchell B. Snyder